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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,916	08/29/2005	Philippe Boyer	0630-1008	5149

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209 Madison Street
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EXAMINER

MAI, HAO D

ART UNIT	PAPER NUMBER
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3732

MAIL DATE	DELIVERY MODE
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06/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,916	Applicant(s) BOYER ET AL.	
	Examiner HAO D. MAI	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 9, 10 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-6, 9-10, 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/24/2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 5-6, and 14, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Claim 1 recites the step “with an inhibiting means, automatically controlling at least one of a luminosity and a chrominance of the camera”, which is not supported by the disclosure. In fact, such claim language contradicts the specification (e.g. previous claims 7-8) which teaches of inhibiting the automatic controlling of the luminosity and/or chrominance.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 3, 9-10, and 14, are rejected under 35 U.S.C. 102(b) as being anticipated by Morris et al. (6,328,567).**

Regarding claims 1 and 9, Morris et al. disclose a method and device for enabling determination of a sample of a color coding ring palette 135 (Fig. 15) whose color is closest to a color of at least part of at least one element 134 of a patient's set of teeth, wherein with the aid of imaging means comprising a video camera said method comprises the steps of: inputting and freezing on a screen a color image 104 of this set-of-teeth element (Fig. 9; column 6 lines 55-67). The method and device further comprises the step and means for filming the color coding ring palette (i.e. the dental shade standard set 135 as shown in Fig. 15) and displaying on the screen the imaging of at least one sample (dental shade tab 109 shown in Fig. 9) so that this image 109 lies side by side joined without separation with the frozen image of the set-of-teeth element so as to allow the user to visually compare the frozen image of the set of teeth element with the image of the sample 109 (Figs. 9 and 15; column 7 lines 51-54; column 8 lines 57-60; column 9 lines 34-59; column 10 line 57- column 11 line 45).

The step of visually comparing the image of the set-of-teeth element frozen on the screen and the image of the sample 109 (Fig. 9) is inherently carried out. Specific to claim 9, note that any basic or more advanced video camera inherently has a "manual" function which inhibits automatic controlling of the luminosity and chrominance of the camera.

As to claims 3, 10, and 14, note that the image 134 of the set-of-teeth element is frozen on the screen and that such image 134 and the sample/dental shade tab 109 are acquired

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separately. The image 134 is acquired by a video camera (column 6 lines 55-67) while the sample dental shade tab 109 is acquired from palette 135 (column 10 lines 57-67).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. (6,328,567).**

Morris et al. disclose the invention substantially as claimed. However, Morris et al. are silent to the samples of the color coding ring palette are made to advance on the screen (claim 2). Morris et al. are also silent to increasing the chrominance and luminosity of the video camera (claims 5-6).

As to claim 2, such claimed sample-advancing technique is well known. For example, Microsoft Word™ has a color chart for the users to select a color for the font, wherein each color in the color chart can be advanced to be previewed for selection. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Morris et al. by enabling the advancing of the samples of the color coding chart 135 (Fig. 15) so that each sample can be individually viewed and evaluated next to the patient's tooth. Furthermore, as to claims 5-6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Morris et al. by increasing the chrominance and/or luminosity of the video camera. Such control or increase on the chrominance and/or luminosity of the video camera is merely a matter of choice well within the skill of an artisan obtained via routine

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experimentation in order to achieve an optimum match between the real object and the image of the object captured by the video camera.

Response to Arguments

8. Applicant's arguments filed 03/24/2009 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hao D Mai/
Examiner, Art Unit 3732

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732

